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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,356	05/24/2001	Olga Bandman	PF-0501-1 DIV	6186

27904 7590 09/30/2002

INCYTE GENOMICS, INC.
3160 PORTER DRIVE
PALO ALTO, CA 94304

EXAMINER
NOLAN, PATRICK J

ART UNIT	PAPER NUMBER
1644	

DATE MAILED: 09/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/866,356	Bandman et al.
Examiner	**Art Unit**
Patrick J. Nolan	1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-47 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims 1-47 are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Part III DETAILED ACTION

1. Claims 1-47 are pending.

Restriction/Election

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-2, 17-18 and 46, drawn to a polypeptide, classified in class 530, subclass 350.

Group II. Claims 3-10, 12, 47, drawn to a polynucleotide, classified in class 536, subclass 23.5.

Group III. Claims 11, 31-32, 34 and 37, drawn to an antibody, classified in class 530, subclass 387.1.

Group IV. Claim 13. Drawn to a nucleic acid probe, classified in class 536 subclass 24.3.

Group V. Claims 14-16, drawn to a method of detecting a target polynucleotide, classified in class 435 subclass 6.

Group VI. Claim 19, drawn to a method of treating by administering a polypeptide, classified in class 424 subclass 184.1.

Group VII. Claim 20, drawn to a method of screening a compound as a agonist, classified in class 435 subclass 4.

Group VIII. Claim 21, drawn to an agonist, classified in class 530 subclass 350.

Group IX. Claim 22, drawn to a method of treating with an agonist, classified in class 424 subclass 184.1.

Group X. Claim 23, drawn to a method of screening a compound as a antagonist, classified in class 435 subclass 4.

Group XI. Claim 24, drawn to an antagonist, classified in class 530 subclass 350.

Group XII. Claim 25, drawn to a method of treating with an antagonist, classified in class 424 subclass 184.1.

Group XIII. Claims 26-27, drawn to a method of screening for compounds that bind to or modulate the polypeptide of claim 1, classified in class 435 subclass 4.

Group XIV. Claims 28-29, drawn to a method of screening with polynucleotides, classified in class 435 subclass 6.

Group XV. Claims 30, 33, 35 and 44, drawn to diagnostic methods with antibody, classified in class 435 subclass 7.1.

Group XVI. Claim 36, drawn to a method of making a polyclonal antibody, classified in class 424 subclass 184.1.

Group XVII. Claim 39 drawn to a method of making a monoclonal antibody, classified in class 435 subclass 326.

Group XVIII. Claim 45, drawn to a method of immuno-purification, classified in class 530 subclass 413.

The inventions are distinct, each from the other because of the following reasons:

3. Groups III and XVI or XVII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product, the antibody can be made by recombinant DNA technology.

Groups I, II, III, IV, VIII, XI are unique products. They differ with respect to their physicochemical properties and are therefore patentably distinct.

Groups V, VI, VII, IX, X, XII, XIII, XIV-XVIII are unique methods. They differ with respect to ingredients and method steps.

Groups I and VI, VII, X, XIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the present case, the product as claimed, the polypeptide can be used in either the treatment methods or screening methods.

Groups II and V, XIV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the present case, the product as claimed, the

polynucleotide can be used in either of the screening methods.

Groups III and XV, XVIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the present case, the product as claimed, the antibody can be used in either the diagnostic method or immunopurification method.

4. Because a search of these 18 distinct inventions would not be co-extensive with a search of the others, an examination and search of two or more inventions in a single application would constitute a serious undue burden on the examiner.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor or at least one claim remaining in the application. Any amendment of the inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48 (b) and by the fee required under 37 CFR 1.17 (h).

7. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is (703) 305-1987. The examiner can normally be reached on Tuesday through Friday from 9:00 am to 5:30 pm.

9. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at (703) 305-3973. The FAX number for our group, 1644, is (703) 305-7401.

Patrick J. Nolan, Ph.D.
Primary Examiner, Group 1640
September 30, 2002